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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------------------|-------------|-----------------------|---------------------|------------------|
| 10/505,145 | 04/08/2005 | Steven Peter Colliver | 056159-5241 | 9553 |
| 9629 | 7590 | 10/18/2007 | EXAMINER | |
| MORGAN LEWIS & BOCKIUS LLP | | | KALLIS, RUSSELL | |
| 1111 PENNSYLVANIA AVENUE NW | | | ART UNIT | PAPER NUMBER |
| WASHINGTON, DC 20004 | | | 1638 | |
| MAIL DATE | | DELIVERY MODE | | |
| 10/18/2007 | | PAPER | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | |
|------------------------------|------------------------|---------------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 10/505,145 | COLLIVER ET AL. |
| | Examiner | Art Unit |
| | Russell Kallis | 1638 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 03 August 2007.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1,2 and 22-39 is/are pending in the application.
 - 4a) Of the above claim(s) 26,27,32 and 33 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1,2,22-24 and 28-39 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 4/08/2005
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) Notice of Informal Patent Application
- 6) Other: _____

DETAILED ACTION

Election/Restrictions

Applicant's election with traverse of Group I, claims 1-2, 22-25, 28-31 and 34-39 in the reply filed on 8/03/2007 is acknowledged. The traversal is on the ground(s) that all the groups require the transgenic plant as instantly claimed. This is not found persuasive because the transgenic plant as broadly claimed was known in the art and therefor does not constitute any technical advance and thus there is no special technical feature uniting the restricted Groups.

The requirement is still deemed proper and is therefore made FINAL.

Claims 1-2, 22-39 are pending. Claims 26-27, 32-33 are withdrawn. Claims 1-2, 22-25, 28-31 and 34-39 are examined.

Drawings

Applicant is required to submit drawings that are separate from the specification. Those that accompanied the specification of the submitted priority document are sufficient for examination, but not for publication.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-2, 22-25, 28-31 and 34-39 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent 7,038,113 filed March 8, 1999.

Applicant broadly claims transformed plants comprising heterologous isoflavone synthase and chalcone reductase; and transformed plants comprising heterologous isoflavone synthase, chalcone reductase and chalcone isomerase; wherein the enzymes are encoded by polynucleotide sequence that hybridize to SEQ ID NO: 1, 3, and 5 under conditions of very low stringency.

U.S. Patent 7,038,113 teaches the production of daidzein in plants transformed with isoflavone synthase, chalcone reductase and chalcone isomerase (see claims and columns 6 line 32 to column 8 line 11; and especially column 14 lines 13 to 43) and that isoflavone synthase, chalcone reductase and chalcone isomerase encoding polynucleotides were known in the art; and thus the reference teaches all the limitations of claims 1-2, 22-25, 28-31 and 34-39.

Art Unit: 1638

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Russell Kallis whose telephone number is (571) 272-0798. The examiner can normally be reached on M-F 8:30-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anne Marie Grunberg can be reached on (571) 272-0975. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Russell Kallis Ph.D.
October, 14, 2007

RUSSELL P. KALLIS, PH.D.
PRIMARY EXAMINER

